

REMARKS

Claims 1-8 are pending in the Application. Claims 1-4 and 6-8 are rejected under 35 U.S.C. § 103(a). Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

Applicants thank the Examiner for discussing the Office Action and in particular the rejection to claim 1 with Applicants' attorney on April 23, 2004.

I. REJECTIONS UNDER 35 U.S.C. § 103(a):

Claims 1-4 and 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suver (U.S. Patent No. 6,016,497) in view of Burger et al. (U.S. Patent No. 6,161,170) (hereinafter "Burger"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. The Examiner has not presented any objective evidence for combining Suver with Burger.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Suver with Burger to profile the data to determine whether the data should be stored in an attribute table or, alternatively, in a merged table and an overflow table and storing the data optimally based on the profiling step, as recited in claim 1, is "so that data can be handled more effectively to further improve system performance." Paper No. 11, page 3. This motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Suver so that data can be handled more effectively to further improve system performance (Examiner's motivation). *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation appears to have been gleaned from the secondary reference, Burger. In fact, the Examiner cites column 10, lines 4-22 of Burger as support for his motivation. Paper No. 11, page 3. This is not evidence as to why one of ordinary skill in the art with a primary reference, Suver, in front of him would have been motivated to modify Suver with the teachings of the secondary reference, Burger. The Examiner's motivation is motivation for the secondary reference, Burger, to solve its problem. This is not a suggestion to combine the primary reference, Suver, with the secondary reference, Burger. The Examiner must provide objective evidence as to why one of ordinary skill in the art with Suver in front of him, which teaches methods for accessing and storing information embedded in the column of a database row, especially useful for complex data (see Abstract), would be motivated to modify Suver with the teachings of Burger, which teaches providing a computer architecture in which the performance typical of on-chip memories can be approached with large off-chip memories (see Column 1, lines 38-40). *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating what the secondary reference teaches is not evidence for combining a primary reference, Suver, with the secondary reference, Burger. *See Id.* Furthermore, there is no suggestion in Suver of handling data more effectively to further improve system performance (Examiner's motivation). Consequently, the Examiner's motivation is

insufficient to support a *prima facie* case of obviousness for rejecting claims 1-4 and 6-8. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, there is no suggestion in Suver of providing a computer architecture in which the performance typical of on-chip memories can be approached with large off-chip memories (as taught in Burger). Since the Examiner has not submitted objective evidence for modifying Suver with Burger, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-4 and 6-8. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Suver to profile the data to determine whether the data should be stored in an attribute table, or alternatively, in a merged table and an overflow table and storing the data optimally based on the profiling step (limitation Suver does not teach). *Id.* There is no suggestion in Suver of profiling data. Neither is there any suggestion in Suver of profiling data to determine whether the data should be stored in an attribute table or, alternatively, in a merged table and an overflow table. Neither is there any suggestion in Suver of storing the data optimally based on profiling the data. Since the Examiner has not submitted objective evidence for modifying Suver to profile the data to determine whether the data should be stored in an attribute table or, alternatively, in the merged table and an overflow table and storing the data optimally based on the profiling step, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-4 and 6-8. *Id.*

As a result of the forgoing, Applicants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-4 and 6-8. M.P.E.P § 2143.

B. Suver and Burger, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Suver and Burger, taken singly or in combination, do not teach or suggest "profiling the data to determine whether the data should be stored in an attribute table or, alternatively, in a merged table and an

overflow table; and storing the data optimally based on the profiling step" as recited in claim 1. The Examiner cites column 3, lines 6-16 as teaching an attribute table. Paper No. 11, page 2. The Examiner further cites table 301 of Suver as teaching a merged table and tables 302 and 303 of Suver as teaching an overflow table. Paper No. 11, page 2. The Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that table 301 teaches a merged table and that table 302 or table 303 teaches an overflow table. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Since the Examiner has not provided any such basis in fact or technical reasoning to support the assertion that table 301 teaches a merged table and that either table 302 or table 303 teaches an overflow table, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 1. M.P.E.P § 2143.

Further, with respect to the above-cited claim limitation, the Examiner cites column 10, lines 4-22; Abstract and Figure 6 of Burger as teaching profiling data to determine where the data is stored and storing the data optimally based on the profiling step. Paper No. 11, page 3. Applicants respectfully traverse and assert that Burger instead teaches profiling a program to determine portions of a program statistically more likely to be executed than another portion of the program. Burger is not teaching how to handle the program, such as where to store the program, as asserted by the Examiner, but instead teaches determining portions of a program statistically more likely to be executed than another portion of the program. Hence, Burger does not teach profiling data to determine where the data is stored and storing the data optimally based on the profiling step. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-4 and 6-8 recite combinations of features including the above combinations, and thus are patentable for at least the above reasons as well. Claims 2-4 and 6-8 recite additional features, which, in combination with the features of the claims upon which they depend are patentable over Suver in view of Burger.

For example, Suver and Burger, taken singly or in combination, do not teach or suggest "wherein the profiling step parses the data to identify entries with single value attributes" as recited in claim 6. The Examiner cites column 1, lines 24-36 and column 3, lines 6-17 of Suver as teaching the above-cited claim limitation. Paper No. 11, page 4. Applicants respectfully traverse and assert that Suver instead teaches that when the data being stored is not a single value, such as plural telephone numbers for a person, a new separate table of rows must be created to store the multiple values, one per row. However, there is no language in the cited passages that teach parsing data to identify entries with single value attributes. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Suver and Burger, taken singly or in combination, do not teach or suggest "wherein the profiling step parses the data to identify given operations that are performed on the data once stored" as recited in claim 7. The Examiner cites Figures 12 and 14 of Suver as teaching the above-cited claim limitation. Paper No. 11, page 4. Applicants respectfully traverse and assert that Suver instead teaches a flow diagram illustrating a computer-implemented method for storing and accessing embedded information in an object-relational database as well as a logic flow diagram of a routine for interpreting a database command. However, there is no language in the description of these Figures that teaches parsing data. Further, there is no language in the descriptions of these Figures that teaches parsing data to identify operations that are performed on the data once stored. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-4 and 6-8 as being unpatentable over Suver in view of Burger. M.P.E.P § 2143.

II. ALLOWABLE SUBJECT MATTER:

The Examiner has objected to claim 5 as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Paper No. 11, page 4. Applicants appreciate the indication of allowability of claim 5.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-8 in the Application are in condition for allowance, and respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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